

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Oleg Kiselev, Ronald S. Karr  
 Assignee: VERITAS Operating Corporation  
 Title: A METHOD OF DATA CACHING IN MIRRORED STORAGE  
 Serial No.: 10/749,862 Filing Date: December 31, 2003  
 Examiner: Jared Ian Rutz Group Art Unit: 2187  
 Docket No.: VRT0058P1US

Austin, Texas  
 January 16, 2007

MAIL STOP AF  
 COMMISSIONER FOR PATENTS  
 P. O. BO 1450  
 Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

Applicants hereby request review of the outstanding rejections, set forth in the Final Office Action mailed August 15, 2006, in the above-identified application. This Request is being filed concurrently with a Notice of Appeal and a Petition for a Two-Month Extension of Time in which to respond to the Final Office Action. No amendments are being filed with this request. This review is requested for the reasons set forth in the Remarks section below.

**REMARKS**

Claims 1, 5, 9, 13, 14 and 18 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 9, and 12 of US Patent No. 7,208,156 (the '156 Patent) in view of US Patent Publication No. 2004/0205298 filed by Bearden et al. (Bearden). The instant application is a continuation in part of the '156 Patent.

MPEP 804 states "before consideration can be given to the issue of double patenting, two or more patents or applications must have at least one common inventor and/or be either commonly assigned/owned or noncommonly assigned/owned but subject to a joint research

agreement as set forth in 35 USC §103(c)(2) and (3) pursuant to the CREATE Act.” While the ‘156 Patent may meet this requirement, Bearden does not. Accordingly, Claims 1, 5, 9, 13, 14 and 18 cannot be rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of the ‘156 Patent in view of Bearden.

An Advisory Action subsequent to the Final Office Action states that Bearden was used to establish that the independent claims of the instant application are obvious variations of claims of the ‘156 Patent. Applicants delineate that Bearden was cited in the Final Office Action for more than attempting to establish that the claims are obvious variations of the claims of the ‘156 Patent; Bearden was cited as teaching limitations of the independent claims of the instant application that are missing from claims of the ‘156 Patent. For example, with reference to the independent claims of the instant application, the Final Office Action asserts that the last limitation of “returning data stored in the cache memory in response to receiving the second read request” is not found in the corresponding ‘156 Patent claims, but can be found in paragraph [0029] of Bearden. The Final Office Action then asserts that it would’ve been obvious to combine the ‘156 Patent with Bearden for the benefit of improving the data rate between the storage system and the requesting computer to obtain the invention of independent claims 1, 9, and 18 of the instant application. In essence, the Final Office Action asserts that the independent claims of the instant application are obvious over claims of the ‘156 Patent in view of Bearden.

Notwithstanding the improper use of Bearden in rejecting the independent claims on the ground of nonstatutory obviousness-type double patenting, Applicants assert the Final Office Action has failed to establish a *prima facie* basis for rejecting the claims as being obvious in view of the combination of the ‘156 Patent claims and Bearden. It is well established that before references can be combined to render a claim obvious under 35 USC §103, the references must teach all the limitations of the claim. The Final Office Action admits that the claims of the ‘156 Patent lacks the requirement of “returning data stored in the cache memory in response to receiving the second read request.” The Final Office Action asserts that Bearden teaches returning data stored in a cache when the data is requested, citing paragraph [0029] of Bearden in support thereof. However, the Final Office Action does not allege that paragraph [0029] of Bearden teaches returning data stored in the cache memory in response to receiving the second read request as required in the independent claims of the instant application. Accordingly, Applicants assert the rejection of

Claims 1, 5, 9, 13, 14, and 18 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 9, and 12 of the '156 Patent in view of Bearden, lacks a *prima facie* basis.

Claims 1 – 6, 9 – 11, 13 and 18 were provisionally rejected on the ground of nonstatutory double patenting over Claims 1 – 4, 8, 14 – 17, and 23 of copending Application No. 10/742,129 (the '129 Application) in view of Bearden. Again, Applicants assert that the rejection of these claims on the ground of nonstatutory double patenting is improper because Bearden lacks a common inventor, is not commonly assigned/owned, and is not subject to a joint research agreement. As such, Applicants submit it is improper to reject Claims 1 – 6, 9 – 11, 13 and 18 on the ground of nonstatutory double patenting over Claims 1 – 4, 8, 14 – 17, and 23 of the '129 Application in view of Bearden.

In an Advisory Action subsequent to the Final Office Action, the Examiner asserts that Bearden was cited to establish that pre-fetching data is likely to be requested by a host, as claimed in the instant application, is an obvious variation of the claimed invention in the '129 Application. Applicants assert that Bearden is cited for more than merely establishing that pre-fetching data is an obvious variation of the claimed invention of the '129 Application; Bearden was cited as teaching limitations of the independent claims of the instant application that are missing in claims of the '129 Application. For example, with reference to the independent claims of the instant application, the Final Office Action asserts that the last limitation of “returning data stored in the cache memory in response to receiving the second read request” of the independent claims is not found in the corresponding '129 Application claims, but presumably can be found in Bearden. The Final Office Action then asserts that it would've been obvious to combine the '129 Application with Bearden for the benefit of improving the data rate between the storage system and the requesting computer to obtain the invention of independent claims 1, 9, and 18 of the instant application. In essence, the Final Office Action asserts that the independent claims of the instant application are obvious over claims of the '129 Application in view of Bearden.

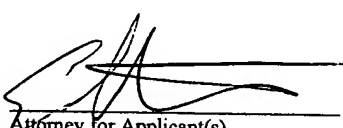
Notwithstanding the improper use of Bearden in rejecting the independent claims on the ground of nonstatutory obviousness-type double patenting, Applicants assert the Final Office Action has failed to establish a *prima facie* basis for rejecting the claims as being obvious in view of the combination of the claims of the '129 Application and Bearden. As noted above, cited sections of Bearden do not teach or fairly suggest returning data stored in

the cache memory in response to receiving the second read request as required in independent Claims 1, 9 and 18. As such, Applicants assert that the Office Action has failed to establish a *prima facie* basis for rejecting Claims 1, 9, and 18 of the instant application as being obvious over claims of the '129 Application and Bearden.

Claims 1, 5, 6, 9 and 18 were provisionally rejected on the ground of nonstatutory double patenting over Claims 24, 25, 32 and 41 of copending Application No. 11/242,216 (the '216 Application). In an Advisory Action subsequent to the Final Office Action, the Examiner asserts that all limitations of Claims 1, 5, 6, 9 and 18 are recited in Claims 24, 25, 32 and 41 of the '216 Application. Applicants respectfully disagree, and note that all recited limitations of, for example, Claim 1 are not found in Claim 24 as alleged in the Final Office Action. For example, Claim 1 of the instant application recites reading data from a first mirror of a data volume, and reading data from a second mirror of the data volume. Claim 24 of the '216 Application does not recite reading data from a first mirror of a data volume and reading data from a second mirror of a data volume. Rather, Claim 24 of the '216 Application recites reading data from a first memory configured to store a data volume, and reading data from a second memory configured to store a mirrored copy of the data volume. Claim 24 of the '216 Application simply does not recite reading data from mirrored copies of a data volume. Claim 18 of the instant application also recites reading data from first and second mirrors. As such, independent Claim 18 is likewise patentably distinguishable over the Claims of the '216 Application.

### CONCLUSION

Applicants assert that the application is in condition for allowance and respectfully request that a finding withdrawing the final rejection of the claims be issued.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA, 22313-1450, on January 16, 2007.	
	<u>1/16/07</u>
Attorney for Applicant(s)	Date of Signature

Respectfully submitted,



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